

The Claims Rejection Under 35 USC § 112

The Examiners rejection of claims 1 and 3 under 35 U.S.C. 112 as being unpatentable over Sperry in view of Hollingsworth has been transversed by the following arguments. The Sperry reference describes a method for using a dunnage bag (a single air compartment) that is placed inside of a container and the present invention has no such limitation. The applicant fails to find any reference in Sperry to an inflatable lining that is attached to the inside of a box. The Sperry claim is quit to the contrary. It requires a dunnage bag that is not attached to the inside walls of the container and is literally placed in the container before use. It appears to the applicant that the Examiner has made a **strained interpretation** of the reference that could only be made by hindsight. As the Courts have stated, "It is impermissible to use the claimed invention as an instruction manual to "template" or piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight construction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention." in re Fritch supra, 1784.

The argument of using Sperry (a bag which cannot in itself be used to ship or carry any objects within itself) is not **legally defensible** and will not stand up in Appeal Court which will not allow the use of hindsight reasoning and the picking and choosing between separate disclosures (Sperry in view of Hollingsworth) in an effort to try to overcome the obvious invention and novelty of the present device (ITS NOT GOGINT TO HAPPEN). The applicant has won many appeals for this very reason. The **Examiner** does understand that multiple use of prior is not allowed? This line of reasoning is only

going to cost the Examiner and Applicant lost time with respect to a patent that will be awarded.

Again, the device of Sperry cites **multiple steps** and requirements (i.e., dunnage bag (a single bag, see FIG 1 in the Sperry specification), a valve connected to the dunnage bag, a valve having a rigid collar, etc.). This device **also** requires flange and shoulder-defining portions, etc. The dunnage bag of Sperry is a single bag that is not capable of covering the inside walls of a container, much less a box. There are no such steps and requirements of the Smith. In contrast the invention of Smith employs an inflatable box with **attached** inner inflatable cushion that covers the item packaged within the box, not a dunnage bag which is thrown into the container.

Again, the Examiners rejection of claims 1 and 3 under 35 U.S.C. 112 as being unpatentable over Sperry in view of Hollingsworth has been transversed by the following arguments. The Hollingsworth device appears to have no relevance in this case. It is an adjustable cushion with a first pad including a compressible substantially rectangular foam piece covered with a pliable non-porous cover. None of the afore mentioned requirements of Hollingsworth are a limitation in the Smith specification. A comparison of the two and one cannot come up with a functional device even if they were combined. In fact, if one were to **combine** Sperry and Hollingsworth one could not come up with the Smith device or a functional device of any kind. Therefore, the rejection based on Sperry and Hollingsworth should be removed and the Smith invention should be allowed.

Again, the Hollingsworth reference describes a method for using a foam cushion which is not even inflatable that is placed inside of a computer carrying case and the present invention has no such limitation. The applicant fails to find any reference in

Hollingsworth reference to an inflatable lining that is attached to the inside of a box. The Hollingsworth claim is quit to the contrary. It requires a foam pad that is adjustable that is attached to the container. The applicant fails to see how a carrying case (ideally for computers) could be compared to a inflatable box for shipping article(s) foregoing the need for peanuts or other shipping supplies. Again, it appears to the applicant that the Examiner has made a **strained interpretation** of the reference that could only be made by hindsight. As the Courts have stated, "It is impermissible to use the claimed invention as an instruction manual to "template" or piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight construction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention." in re Fritch supra, 1784.

Again, the device of Hollingsworth cites **multiple steps** and requirements (i.e., adjustable, positionable foam cushion, foam cushion in a compartment with a releasable fastener element, a substrate on the top surface, flexible hinge, a non-porous cover, etc.). There are no such steps and requirements of the Smith device. In contrast the invention of Smith employs an inflatable box with **attached** inner inflatable cushion that covers the item packaged within the box, not a foam pad which is removable, with a required.

Again, the Hollingsworth device appears to have no relevance in this case. It is a adjustable cushion with a first pad including a compressible substantially rectangular foam piece covered with a pliable non-porous cover. None of the afore mentioned requirements of Hollingsworth are a limitation in the Smith specification. A comparison of the two and one cannot come up with a functional device even if they were combined. Again, and in fact, if one were to **combine** Sperry and Hollingsworth one could not come

up with the Smith device or a functional device of any kind. Therefore, the rejection based on Sperry and Hollingsworth should be removed and the Smith invention should be allowed.

Again, the physical features of Smith are completely different (**novel**) from that of Sperry in view of Hollingsworth. The reference of Sperry in view of Hollingsworth **teaches away** from the Smith in that Smith invention is for the use of shipping disposable boxes that have the ability to completely cover the package from all sides because of an attached inner liner on the bottom and sides of the box that was not taught, envisioned, or even mentioned by Sperry in view of Hollingsworth. The device of Smith is an advancement in the art and over the prior. The present art is **patentably distinct** and "**novel**" in structure and functionality over the Sperry in view of Hollingsworth device. Because of this and other reasons the Smith device is not limited to all of the requirements of the Sperry in view of Hollingsworth.

Again, the Examiner rejection to claims 1 and 3 as being unpatentable over Sperry in view of Hollingsworth under 35 U.S.C. § 112 should be reversed because Sperry in view of Hollingsworth does not teach applicant's limitations as claimed, i.e., inflatable box (not a single compartment dunnage bag), inflatable cushion that covers the inside walls and bottom of the box, etc. The Courts have stated, "Further, the reference must describe the applicant's claimed invention sufficiently to have placed a person of ordinary skill in the field of the invention in possession of it." The Sperry in view of Hollingsworth references does not because it fails to disclose the device of Smith and does not have all of the limitation of the Smith device, that does not require the use of adjustable, positionable, foam cushion in a compartment with a releasable fastener

element, a substrate on the top surface, flexible hinge, a non-porous cover, a single compartment dunnage bag, a valve connected to the dunnage bag, a valve having a rigid collar, etc.

Again, and in addition there is no teaching by Sperry in view of Hollingsworth of the Smith device. The ability of the present art produces **unexpected results** because without the use of an inflatable device that has a bottom and side inflatable cushion the item being placed into the box for shipment would not have complete protection. In fact, if this were obvious to one in the art then why has it never been taught or used. Those skilled in the art would have surely implemented it by now. The **lack of this showing** from those 'skilled in the art' shows that it has been not implemented and the use of an inflatable box of the present art, despite its great advantages, indicates that it is not obvious because of that lack of showing by those skilled in the art. The reference cannot be used or related to the present art because the prior and present art take **different paths** to reach different solutions to different problems. The prior art methods are described to used a single compartment dunnage bag which at best can only cover one side of the article being shipped which will expose the other sides to damage from impact, or the art of using a foam cushion in a computer carrying case. One cannot use the present art to enable the prior art so that it can be use to ship articles in the manner of the present device.

Again, the device of Smith uses a "**new principle of operation**" in that the use of an inflatable box with an inflatable cushion that covers the inside walls and the bottom of the box for complete protection of the article to be placed the inflatable box for shipping that was not taught by the prior art and is absolutely novel in structure and function as

compared to the prior art. The applicant's invention solves a different problem than the reference, and such differences are cited in the claims, such as no required foam cushions, dunnage bag, fasteners, etc. See *In re Wright*, 6 USPQ 2d 1959 (1988).

Again, the Examiner should reverse the rejection of claims 1 and 3 under 35 U.S.C. § 112 as being unpatentable over Sperry in view of Hollingsworth because applicant's device recites novel physical features which are unobvious under § 112.

Again, the limitations of Sperry in view of Hollingsworth does not allow for the **unsuggested** and **superior** capability of the present device. Without a showing in the Smith patent that a complicated device with multiple steps, and the use of foam cushions, dunnage bags, fastener elements, etc., is required (which there is none) the rejection by the Examiner improper. The present device **omits elements** certain and critical elements of the Sperry in view of Hollingsworth device namely the present art does not require dunnage bags, foam cushions, fasteners, adjustable and positionable foam cushion, foam cushion in a compartment with a releasable fastener element, a substrate on the top surface, flexible hinge, a non-porous cover, etc., to name a few. The present art by not including these elements of the prior art is in fact more capable of producing a more **usable, superior and economically feasible** device.

Again and thus the applicant submits that its invention clearly recites novel physical subject matter which distinguishes over any use of Sperry in view of Hollingsworth as a prior art or teaching.

Again, The Novel Physical features of Claims 1 and 3 Produce New And Unexpected Results And Hence Are Unobvious And Patentable Over The Reference Under § 112.

Again, Such hindsight reconstruction of an invention to support a rejection under 35 U.S.C. 112 is improper as clearly set forth by the Court of Appeals For the Federal Circuit in *In re Fritch*, 23 USPQ 2d 1780 at 1783-1784 (CAFC 1992) where it is stated, "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination" "Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This Court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures of the prior art to deprecate the claimed invention'."

Again and for these reasons, the Examiner's rejection of claims 1 and 3 under 35 U.S.C. § 112 should be reversed.

Again, Applicant's invention of claims 1 and 3 are not obvious when compared to the prior art of Sperry (**a bag that not itself be used for shipping or storage of items for shipping**) in view of Hollingsworth (**a suitcase not is not designed for shipping for carrying clothes, etc.**) because such prior art as a whole does not teach applicant's invention. Rather, some of the prior art teaches various aspects of containers, dunnage bags, computer carrying cases which are in no manner even slightly similar to the present art. Furthermore, no suggestion is made by any of the prior arts elements to form applicant's device. For these reasons the applicant is entitled to allowance of claims 1 and 3. For the Examiner to disprove the applicant's device based on the use of Sperry in view of Hollingsworth for the basis is improper and not **legally defensible**.

Again, one cannot pick and choose from prior art references to prove obviousness absent some teaching or suggestion supporting the use. **Under section 112**, "teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fritch, 23 USPQ 2d 1780, 1783 (CAFC 1992).

Again, Applicants request reconsideration for the following reasons:

(1) These novel physical features of claims 1 and 3 produce novel and unexpected results and hence are unobvious and patentable over the reference(s).

Again, the prior art does not teach the present art or solve any problems of the prior art then why the rejection? 35 U.S.C. 112 **does not require** all of the elements of the prior art to be used in combination. Therefore, and in fact, if the Examiner uses any combination of the prior art and still does not create the present art it in fact invalidates the Examiners argument.

Again, the suggestion to combine the references should not come from applicant was forcefully stated in Orthopedic Equipment Co. v. United States, 217 U.S.P.Q. 193, 199 (CAFC 1983):

"It is wrong to use the patent in suit [here the patent application] as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit [here the claims pending]. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law [here the PTO]."

As was further stated in Uniroyal, Inc. v. Rudkin-Wiley Corp., 5 U.S.P.Q.2d 1434 (C.A.F.C. 1988), "[w]here prior-art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination

other than the hindsight gleaned from the invention itself.... Something in the prior art must suggest the desirability and thus the obviousness of making the combination," [Emphasis supplied.]

In line with these decisions, recently the Board stated in Ex parte Levensgood, 28 U.S.P.Q.2d 1300 (P.T.O.B.A.&I. 1993):

"In order to establish a *prima facie* case of the obviousness, it is necessary for the examiner to present *evidence*, preferable in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art *would have been led* to combine the relevant teachings of the applied reference(s) in the proposed manner to arrive at the claimed invention. ...That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can *reconstruct* and/or explain the theoretical mechanism of an invention by mean of logic and sound scientific reasoning *does not* afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.... Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing a *prima facie* case of obviousness only by showing some objective teaching in either prior art, or knowledge generally available to one of ordinary skill in the art, that 'would lead' that individual 'to combine the relevant teachings of the references.' ... Accordingly, an examiner cannot establish obviousness by locating references which describe various aspects of a patent applicant's invention without also providing evidence

of the *motivating force* which would impel one skilled in the art to do what the *applicant has done.*"

Again, in the present case, there is no reason to support the use of Sperry in view of Hollingsworth as a teaching to establish obviousness when the extent of the teaching are at best only considered "**conceivable or possible**" by the prior art. This is not sufficient teaching to establish obviousness. However the fact that the reference teaches a device that is supposed to be used for carrying computers or the required use of a dunnage bag is not sufficient to **gratuitously and selectively** substitute parts of the reference and combined in a manner that was unsuggested by the prior art in order to attempt to meet applicants' novel claimed invention.

Again, the applicant respectfully request that the rejection of claims 1 and 3 be reversed and if the Examiner continues to reject the claims upon any combination of references, that the Examiner include an explanation, in accordance with M.P.E.P. § 706.02, Ex parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A. 1985), and Ex parte Levengood, supra, a "factual basis to support the Examiner's conclusion that it would have been obvious" to use Sperry in view of Hollingsworth as a prior art reference that is designed for a completely different functionality and use.

Again, even if Sperry in view of Hollingsworth heterogeneous and homogeneous references were To Be Combined In The Manner Proposed, The Proposed Combination Would Not Show All Of The Novel Physical Features Of The Claims

Again, the following are the requirement(s) of the prior art versus present art:

Required	Present Art (Smith)	Prior Art
Releasable fastener element	no	yes
Foam cushion	no	yes
Flexible hinge	no	yes
Substrate/non-porous cover	no	yes
Multiple pads	no	yes
Dunnage bag	no	yes
valve with a rigid collar	no	yes
Flexible collar	no	yes

For these reasons, the Examiner's rejection of amended claims 1 and 3 under 35 U.S.C. § 112 should be reversed.

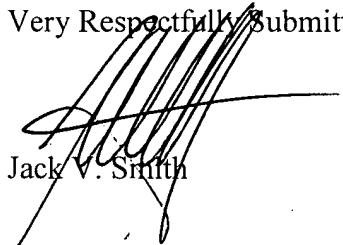
Conclusion

Again, and for all of the above reasons, applicant submits that the specification and claims are in proper form, and that the claims 1, 3 and 5 define patentably over the prior art. Therefore the applicant submits that this application is now in condition for allowance, which action is respectfully solicited.

Conditional Request For Constructive Assistance

Applicant has amended the specification and claims of this application as requested by the Examiner so that they are proper, definite, and define novel structure which is also unobvious. If, for any reason this application is not believed to be in full condition for allowance, applicant respectfully requests the constructive assistance and suggestions of the Examiner pursuant to M.P.E.P. § 107.03(d) and § 707.07(j) in order that the undersigned can place this application in allowable condition as soon as possible and without the need for further proceedings.

Very Respectfully Submitted,



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Jack V. Smith

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